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First Named Inventor	Hitoshi Sekine
Group Art Unit	2172
Examiner Name	Fred I. Ehichioya
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Date	March 20, 2006

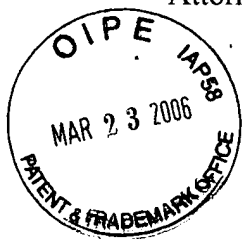
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OID 1995-22 DIV1



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Confirmation No. 1948

Hitoshi Sekine et al.

Group Art Unit No.: 2162

Serial No.: 09/782,988

Examiner: Fred I. Ehichioya

Filed: February 13, 2001

For: **METHOD AND APPARATUS FOR STORING AND MANAGING DATA**

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REPLY BRIEF

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed on January

18, 2006.

I. STATUS OF CLAIMS

Claims 1-4, 6-14, 16-24 and 26-31 are pending in this application, were finally rejected and are the subject of this appeal. Claims 5, 15 and 25 were canceled during prosecution. The claims are exactly the same as when the original Appeal Brief was filed in the USPTO on December 3, 2004.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

In the Office Action mailed on March 11, 2005, (referred to hereinafter as the “Office Action”), the claims were rejected under new grounds. The new grounds of rejection essentially replace the *Moon et al.*, U.S. Patent 6,408,338 reference with an article “Integrated CD-ROM and WORM Optical Disk Systems on the Navy’s Paperless Ship,” by *Thomas J. Thiel* (hereinafter “*Thiel*”). Accordingly, after the Office Action, the grounds of rejection to be reviewed on appeal are as follows:

1. Claims 1-3, 8-13, 18-23 and 28-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ramsay et al.*, U.S. Patent 5,502,576 (hereinafter “*Ramsay*”) in view of *Thiel*.
2. Claims 4, 6, 7, 14, 16, 17, 24, 26 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ramsay* in view of *Thiel* and further in view of *Kern*, U.S. Patent 6,202,124 (hereinafter “*Kern*”).

III. ARGUMENTS

After studying the Examiner's Answer mailed on January 18, 2006, Applicant respectfully submits that there may be a misunderstanding about what is actually recited in Claim 1 and is hopeful that these remarks will clarify the distinctions between what is recited in Claim 1 and what is taught by *Thiel*. It is respectfully submitted that the central issue is whether the *Thiel* reference teaches or suggests the Claim 1 limitation "in response to processing the search query against the digital data stored on the WORM storage device, generate data that identifies data stored on the WORM storage device that satisfies the search query." For convenience, Claim 1 is reproduced below:

CLAIM 1

Claim 1 recites a data storage apparatus that requires:

"an interface configured to receive digital data; and
a data processor communicatively coupled to the interface and being configured to:
 automatically receive digital data from the interface and cause the digital data
 to be stored to a write-once-read-many (WORM) storage device,
 process a search query against the digital data stored on the WORM storage
 device, and
 in response to processing the search query against the digital data stored on the
 WORM storage device, generate data that identifies data stored on the
 WORM storage device that satisfies the search query."

Claim 1 does not merely recite processing a query against digital data stored on a WORM device and then retrieving data from the WORM device that satisfies the query. Claim 1 recites that the data processor is configured to "in response to processing the search query against the digital data stored on the WORM storage device, generate data that identifies data stored on the WORM storage device that satisfies the search query." Thus, Claim 1 is not directed towards retrieving data that satisfies a query, as is done in conventional systems. Rather, Claim 1 is directed to generating data "that identifies data stored on the WORM storage device that satisfies the search query" in response to processing the query. For purposes of explanation, it may be useful to consider the data generated in Claim 1 as metadata, i.e., data that describes other data, rather than the data itself that satisfies the query. Thus, for a reference to teach or suggest the aforementioned limitations recited in Claim 1, the reference must teach or suggest not just

processing a search query and retrieving the data that satisfies the search query, but it must teach or suggest in response to processing the search query, generating data “that identifies data stored on the WORM storage device that satisfies the search query.”

In the Examiner’s Answer, the Examiner reiterated that the Claim 1 limitation “in response to processing the search query against the digital data stored on the WORM storage device, generate data that identifies data stored on the WORM storage device that satisfies the search query” is taught by the text in *Thiel* at Pages 18-19 describing WORM systems and the text at Page 21, paragraphs 4-6 describing the TOPS Functionality and Software. Examiner’s Answer, Page 9, last paragraph, through Page 10, first paragraph. More specifically, in the Examiner’s Answer, a completed form provided by the TOPS system of *Thiel* (a completed form is a blank form image coupled with data from the database) is considered to be the “data stored on the WORM storage device that satisfies the search query” recited in Claim 1. Examiner’s Answer, Page 9, last paragraph, through Page 10, first paragraph.

Assuming that a query for a form in *Thiel* is considered to be the “search query” recited in Claim 1 and that a completed form in *Thiel* is considered to be the “data stored on the WORM storage device that satisfies the search query” recited in Claim 1, then for *Thiel* to teach or suggest the aforementioned limitation, *Thiel* would have to teach or suggest that, in response to a search query for a completed form, the TOPS system generates data that identifies the completed form. It is respectfully submitted that there is no such teaching or suggestion in the *Thiel* reference. *Thiel* does not teach or suggest that any data is generated that identifies a completed form that satisfies a search query, where the data is generated in response to processing a search query against the blank forms stored on the WORM device. Rather, the TOPS system merely retrieves the blank form and couples it with data from the database to provide a completed form.

The Examiner’s Answer asserted that the Examiner considers the printing of a completed form in *Thiel* to be the generating “data that identifies data stored on the WORM storage device that satisfies the search query” recited in Claim 1. Examiner’s Answer, Page 9, last paragraph, through Page 10, first paragraph. Printing a completed form involves nothing more than creating a physical representation of the electronic version of the completed form. The printed version of the completed form does not contain anything more than the electronic version of the completed form. There is no teaching or suggestion in *Thiel* that printing a completed form in any way involves generating data that indicates that the completed form is the data stored on the WORM

device that satisfies the search query. It is therefore respectfully submitted that the description in *Thiel* of printing of a completed form from the TOPS system does not teach or suggest the Claim 1 limitation "generate data that identifies data stored on the WORM storage device that satisfies the search query," since no data is generated that identifies the form that satisfies the query.

In view of the foregoing, it is respectfully submitted that Claim 1 recites one or more limitations that are not taught or suggested by *Ramsay* and *Thiel*, considered alone or in combination, and that Claim 1 is therefore patentable over *Ramsay* and *Thiel*. All of the other remarks provided in the Supplemental Appeal Brief filed with the Request for Reinstatement of Appeal filed on June 7, 2005 are respectfully maintained.

IV. CONCLUSION AND PRAYER FOR RELIEF

Based on the foregoing, it is respectfully submitted that the rejection of Claims 1-3, 8-13, 18-23 and 28-31 under 35 U.S.C. § 103 being unpatentable over *Ramsay* in view of *Thiel* lacks the requisite factual and legal bases. Appellants therefore respectfully request that the Honorable Board reverse the rejection of Claims 1-3, 8-13, 18-23 and 28-31 under 35 U.S.C. § 103 over *Ramsay* in view of *Thiel*. It is further respectfully submitted that the rejection of Claims 4, 6, 7, 14, 16, 17, 24, 26 and 27 under 35 U.S.C. § 103(a) as being unpatentable over *Ramsay* in view of *Thiel* and further in view of *Kern*, lacks the requisite factual and legal bases. Appellants therefore respectfully request that the Honorable Board reverse the rejection of Claims 4, 6, 7, 14, 16, 17, 24, 26 and 27 under 35 U.S.C. § 103 over *Ramsay* in view of *Thiel* and further in view of *Kern*.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



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Reg. No. 37,777

Date: March 20, 2006

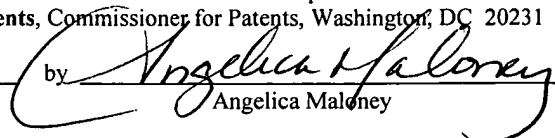
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